

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q64716

Michihiro HAZUMI

Appln. No.: 09/864,261

Group Art Unit: 3694

Confirmation No.: 3205

Examiner: Martin A. GOTTSCHALK

Filed: May 25, 2001

For: ELECTRONIC MEDICAL RECORD INFORMATION MANAGEMENT SYSTEM AND
METHOD THEREOF

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits
this Reply Brief in response to the Examiner's Answer dated April 2, 2008. Entry of this Reply
Brief is respectfully requested.

Table of Contents

STATUS OF CLAIMS	3
GROUND OF REJECTION TO BE REVIEWED ON APPEAL	4
ARGUMENT	5
CONCLUSION	9

STATUS OF CLAIMS

Claims 2, 8, 10, 14, 16, 18, 22, 25, 26 and 28-30 are all the claims pending in the present Application.

Claims 2, 8, 10, 14, 16, 22, 25, 26 and 30 presently stand rejected under 35 U.S.C. § 102(b). In addition, claims 18, 28 and 29 stand rejected under 35 U.S.C. § 103(a).

The rejected claims 2, 8, 10, 14, 16, 18, 22, 25, 26 and 28-30 are being appealed.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

There are three issues on Appeal. The first issue is whether claims 2, 8, 10, 14, 16, 22, 25, 26 and 30 are improperly finally rejected under 35 U.S.C. § 102(b) as being anticipated by Ross, Jr. et al. (U.S. Pat. No. 5,823,948).

The second issue is whether claims 18 and 28 and 29 are improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over Ross and further in view of Wallace et al. (U.S. Pat. No. 6,564,121).

The third issue is whether the Examiner has properly considered Appellant's arguments during the prosecution of the present Application.

ARGUMENT

Appellant notes that pages 5-14 of the Examiner's Answer to the Appellant's Brief simply reproduce the arguments presented by the Examiner in the Final Office Action. The Appellant therefore is not presenting any additional arguments in response, other than reiterating the arguments made in the Appeal brief filed on February 5, 2008. Appellant addresses herein the additional arguments presented by the Examiner on pages 14-20. The reply to the Examiner's Answer can be found below.

With regard to independent claim 2, Appellant asserted that Ross fails to disclose, or even suggest, at least the "control server [which] judges whether **a user who transmitted said request** is a user who has a second access right or not, and **when said user has said second access right, said control server makes said electronic medical record storer store said electronic medical records.**"

The Examiner disagreed and in Response, *inter alia*, states:

Appellant goes on to categorically state that, "...in Ross, all users, once so validated, have automatic access to all patient records." Appellant provides no citation in the Ross reference for this assertion, and the Examiner has not been able to find such evidence either. For example, nowhere in Ross is it stated or implied that a physician has access to all patient records, regardless of whether or not the patient is a patient of that physician.

See Examiner's Answer, page 16.

Appellant respectfully submits that the Examiner misunderstood the statement. That is, Appellant simply notes that once a user is properly validated (i.e., granted rights to the entire system), that user would have access to every patient's records. This means that, with proper permission, or access rights, a user could have access to the entire system. In fact, the system in

Ross only implies a distinction between classes of users, i.e. records clerk vs. physician, and not between users within the same class, i.e., physician vs. physician.

On one point, however, the Appellant agrees with the Examiner -- The Ross reference does not describe, or even imply, who has access to patient records and how much access each user has. As the Examiner stated “**nowhere in Ross is it stated or implied that a physician has access to all patient records, regardless of whether or not the patient is a patient of that physician.**” Respectfully, Appellant notes that it is the Examiner’s burden to show each element being met by the reference, and the Examiner, by his own admission, cannot meet this burden.

In the Appeal Brief, Appellant also argued that “Ross does not disclose that a control server makes **a rights determination after a request for a patient record has been made.**” In response, the Examiner asserts that “Appellant is apparently relying on the temporal relationship between 1) when a request is sent, and 2) when the determination is made as to whether or not the sender has an access right, to establish the uniqueness of this feature.” (See, Office Action, page 16).

Appellant respectfully notes that, as set forth in the Appeal brief, **there is in fact a temporal relationship that is claimed.**

The Examiner goes on to state that “in the system of Ross, if a nurse tries to write a prescription request for a particular patient, the system determines that the nurse does not have proper access and rejects this request, since only a physician may write a prescription.” (See Office Action, pages 16-17). Initially, Appellant notes that **the Examiner himself has provided**

no citation for this statement, despite accusing the Appellant of this very same error just paragraphs above, nor does Ross teach what the Examiner asserts.

Second, Appellant notes that there is a difference between writing a prescription (the teaching relied on by the Examiner) and making a request for records (as recited in the claim). For example, there is no evidence that a request needs to be made of the server before a prescription can be generated. Nor is this feature inherent to the system of Ross. In fact, the ability to generate a prescription can be an option that is available to the physician, but is unavailable to the nurse, or other unauthorized users. In other words, there is no evidence that the nurse, or any unauthorized user, can even attempt to write a prescription, wherein that attempt is denied by the system, as the Examiner asserts.

Conversely, as the Appellant set forth in the Appeal brief, **there is no teaching of authenticating the user's rights after the user makes any request**, be that for a prescription or a medical record. Instead, the user's **entire set of rights** is defined once the user logs into the system.

With respect to the rejection of claims 18, 28 and 29 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ross and further in view of Wallace et al. (U.S. Pat. No. 6,564,121), Appellant addresses the Examiner's response, as set forth below.

With respect to the Examiner's proposed combination, Appellant indicated that this combination is improper, because, among other reasons, there was no reasoning or rational underpinning to make the proposed combination.

For example, the Examiner, in his Answer, alleges that “Wallace solves the problem of encryption, and the asserted concern with efficiency is not relevant.” (See Office Action, page 19). This statement is incorrect for several reasons.

First, Wallace does not “solve the problem of encryption” with respect to Ross, because **no such problem exists in Ross**. Instead, Ross relies on an alternate method for protecting the data on its system. Specifically, in Ross, personnel must clearly **demonstrate their identity to gain access to the system**. As such, there is no need in Ross to encrypt or decrypt the data being transmitted, as the user must have already been validated before even receiving access to the system. Simply adding additional encryption to the centralized system of Ross would be redundant.

Second, the Examiner asserts that “the asserted concern with efficiency is not relevant.” Appellant respectfully disagrees. In fact, as set forth in the Appeal Brief, Ross is directed to a centralized system, while Wallace is directed to a de-centralized, distributed system. As such, data in Wallace is protected by encryption because this data travels outside of the system’s protection. Conversely, in Ross, data only travels within the centralized and secured system. As described above, the system of Ross is secured via the validation procedure. There is simply no need to encrypt the data of Ross, because this data is already secured.

Appellant respectfully asserts that one of ordinary skill in the art would not add encryption to Ross’ centralized system, as this would be redundant, inefficient, and unnecessary. In fact, it seems that the Examiner is simply using the Appellant’s disclosure as a blueprint, and as such relying on impermissible hindsight to reject the Appellant’s Application.

Additional Note - Claim rejections -- 35 U.S.C. § 102

Last, Appellant notes that the Examiner has rejected claims 2, 8, 10, 14, 16, 22, 25, 26 and 30 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Ross, Jr. et al. (U.S. Pat. No. 5,823,948). However, claim 14 is not addressed on the merits in the Final Office Action, the Examiner's Answer, or throughout the prosecution of this Application.

CONCLUSION

For the above reasons, as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,

/Artem N. Sokolov/

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

Artem N. Sokolov
Registration No. 61,325

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: June 2, 2008